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In re Application of:
JONES, David, H., A., et al. : DECISION ON RENEWED PETITION
Application No. 10/644,256 :
Filed: August 20, 2003 :
Attorney Docket No. 2578-6077US :

This is a decision on the “Petition under 37 CFR 1.78(a)(3) For Acceptance Of Unintentionally Delayed Priority Claims” filed November 24, 2008, treated herein under 37 CFR 1.78(a)(3) and 1.78(a)(6) and 37 CFR 1.55(c).

For the reasons discussed below, the petition is **DISMISSED**.

37 CFR 1.78(a)(3) applies where an applicant seeks to add a late claim of benefit under 35 U.S.C. 120 and 365(c) to a prior-filed international application designating the United States; 37 CFR 1.78(a)(6) applies where an applicant seeks to add a late claim of priority to a prior-filed provisional application. In the present petition, applicants are seeking to add domestic priority claims to two international applications (PCT/EP2003/007690 and PCT/EP03/50201) and to a U.S. provisional application (60/397,066). Accordingly, the present petition is properly considered under both 37 CFR 1.78(a)(3) and (a)(6).

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii).

The present non-provisional application was filed after November 29, 2000, and the claims herein for the benefit of priority to the prior-filed applications were submitted after expiration of the periods specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3) and 1.78(a)(6).

A grantable petition under 37 CFR 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. 120 and 119(e) and 37 CFR 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional.

The present petition fails to comply with item (1) above.

The amendment filed herein on 20 November 2006 fails to properly indicate the relationship between the two international applications, as required for a domestic benefit claim. Specifically, the amendment indicates that PCT/EP2003/007690 "claims the benefit of" PCT/EP03/50201. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part. See MPEP 201.11(III)(A):

Except for benefit claims to the prior application in a continued prosecution application (CPA), benefit claims under 35 U.S.C. 120, 121, and 365(c) must identify the prior application by application number, or by international application number and international filing date, and indicate the relationship between the applications. See 37 CFR 1.78(a)(2)(i). The relationship between the applications is whether the instant application is a continuation, divisional, or continuation-in-part of the prior nonprovisional application. An example of a proper benefit claim is "this application is a continuation of prior Application No. ---, filed ---." A benefit claim that merely states that "this application claims the benefit of Application No. ---, filed ---" does not comply with 35 U.S.C. 120 and 37 CFR 1.78(a)(2)(i), since the relationship between the applications is not stated.

In addition, where, as here, a chain of domestic priority between multiple applications is asserted, then each application in the chain must include a reference specifically identifying its relationship with any prior-filed applications. See MPEP 201.11(III)(C):

The reference to the prior applications must identify all of the prior applications and indicate the relationship (i.e., continuation, divisional, or continuation-in-part) between each nonprovisional application in order to establish copendency throughout the entire chain of prior applications. Appropriate references must be made in each intermediate application in the chain of prior applications. If an applicant desires, for example, the following benefit claim: "this application is a continuation of Application No. C, filed ---, which is a continuation of Application No. B, filed ---, which claims the benefit of provisional Application No. A, filed ---," then Application No. C must have a reference to Application No. B and provisional Application No. A, and Application No. B must have a reference to provisional Application No. A.

It is noted that a review of PCT/EP2003/007690 indicates that the first line of the specification of such application does not include a reference identifying the application as a continuation, continuation-in-part, or divisional of PCT/EP03/50201.

Before the petition under 37 CFR 1.78(a)(3) and (a)(6) can be granted, a renewed petition under 37 CFR 1.78(a)(3) and a substitute amendment¹ or supplemental ADS (37 CFR 1.76) which properly sets forth the relationship of the prior-filed international application(s) is required. In addition, any such reference would need to be consistent with a reference in intermediate application PCT/EP2003/007690.²

It is apparent that instead of a domestic benefit claim under 35 U.S.C. 365(c), applicant may have intended to make a claim of foreign priority to PCT/EP03/50201 under 35 U.S.C. 365(b). If this is the case, then the claim for foreign priority must be set forth in an oath or declaration or an ADS (see 37 CFR 1.63(c)(2)). Because a proper claim of foreign priority was not made before the expiration of the period set forth in 37 CFR 1.55(a)(1)(I), a petition under 37 CFR 1.55(c) would be required to add such foreign priority claim.

Finally, it is noted that the petition also seeks to add a claim of "domestic priority" to European Patent Application No. 02077953.4. By definition, a domestic priority claim (i.e., a claim under 35 U.S.C. 119(e), 120 or 365(c)) may only be directed to a prior filed U.S. application or to an international application designating the United States. A benefit claim directed to a foreign application such as EP 02077953.4 is a foreign priority claim made under 35 U.S.C. 119(a)-(d) or 365(a)-(b), and the addition of a delayed foreign priority claim requires a grantable petition under 37 CFR 1.55(c). As the present petition does not include a specific request under 37 CFR 1.55(c) to add a foreign benefit claim to European Patent Application No. 02077953.4, such benefit claim may not be added on the present record.

Based on the above, applicants' renewed petition to add benefit claims directed to international applications PCT/EP2003/007690 and PCT/EP03/50201, European Patent Application No. 02077953.4, and U.S. provisional application 60/397,066 is not grantable on the present record.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PCT
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¹ Note 37 CFR 1.121

² It is noted that the reference to US provisional application 60/397,066 is in acceptable form.

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Any questions concerning this matter may be directed to Richard Ross at (571) 272-3296.

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